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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/886,485 07/01/97 EATON

M 7282

LM02/0413

EXAMINER
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BONAVITO, K

ART UNIT	PAPER NUMBER
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2761

DATE MAILED:

04/13/99

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/886,485**

Applicant(s)  
**Eaton et al**

Examiner  
**Kevin Bonavito**

Group Art Unit  
**2761**



☒ Responsive to communication(s) filed on Feb 16, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-16 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-16 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on Feb 16, 1999 is ☒ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Drawings*

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on February 16, 1999 have been approved.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-16 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-8 of copending Application No. 09/176,510. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common

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subject matter, as follows: With respect to claim 1 of each application, both claim a multi-transaction services system comprising a plurality of service request and supply channels, each channel including channel-specific hardware and software; at least one operation means including operation specific hardware and software; and an integrated channel manager connected between the channels and the operation means, the integrated channel manager having 3 layers, a first interface layer for interfacing the channel specific components of each channel, a second interface layer for interfacing the operation means , and a third layer in between the first and second interface layers and including at least one application service connectable to each channel in a channel-independent manner. Claim 1 of the instant application recites a further limitation of the specific functioning of the application service and operation means. However, the “comprising” language of claim 1 of the copending application allows for additional limitations from the specification to be added, and since the specifications of both applications have common subject matter, the scope of claim 1 of the instant application is covered by claim 1 of the copending application. The same reasoning holds true for claims 4 and 5 of the respective applications, while claims 2, 3, 6, 7 and 8 of the instant application are the same as of 2, 3, 6, 7 and 8 of the copending application except for the fact that claims 2, 3, 6, 7 and 8 of the instant application also have the additional limitations of their claim 1.

Claims 9-16 of the instant application are method claims with the same limitations as claims 1-8 of the instant application, and as such they parallel the invention recited in those claims. Thus the double patenting rejection applied to claims 1-8 applies to claims 9-16 as well.

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Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804


4. Claims 1-16 would be allowable upon filing of a terminal disclaimer.
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Bonavito whose telephone number is (703) 305-9769. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Voeltz, can be reached on (703) 305-9714. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-0040

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

kfb

April 9, 1999

  
ROBERT A. WEINHARDT  
PRIMARY EXAMINER